

Application No. 09/398,229
Amendment dated November 27, 2006
Response to Office Action of August 24, 2006

Atty. Docket No. 74451.P100
Examiner Boutah, Alina A.
TC/A.U. 2143

Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. No claims have been amended, added or canceled herein. Claim 2 was previously canceled. Thus, claims 1 and 3-45 are pending.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1, 4, 14, 17, 22 and 28-45 were rejected as being unpatentable over U.S. Patent No. 5,848,413 issued to Wolff, et al. (*Wolff*) in view of U.S. Patent No. 5,692,048 issued to Gormish, et al. (*Gormish*) and further in view of U.S. Patent No. 6,584,508 issued to Epstein, et al. (*Epstein*) and further in view of U.S. Patent No. 6,742,116 issued to Matsui (*Matsui*).

Claim 1 recites:

a server coupled to the filter and to the multifunction machine, the server having memory to store the multiple electronic documents, *the server to select and to publish a subset of electronic documents* by selectively transmitting a document identifier and authorization information to one or more recipients, the document identifier and the authorization information to enable the one or more recipients to access one or more of *the subset of electronic documents*.

Thus, Applicants claim selecting a publishing a subset of electronic documents by selectively transmitting a document identifier and authorization information to one or more recipients. Claims 14, 17, 22 and 28 recite similar limitations.

As a preliminary matter, the Office Action does not address the claim language directed to publishing subset of electronic documents. Further, Applicants note that the purposes of the authorization information as disclosed by *Matsui* is significantly different

Application No. 09/398,229
Amendment dated November 27, 2006
Response to Office Action of August 24, 2006

Atty. Docket No. 74451.P100
Examiner Boutah, Alina A.
TC/A.U. 2143

that the claimed use of authorization information. *Matsui* is directed to a chat client that allows multiple users to engage in a text-based "conversation." See Figs. 2 and 3.

Matsui does not relate to or even suggest use with electronic documents published in the manner as claimed. Therefore, it would not have been obvious to combine *Matsui* with the other cited references.

The section of *Wolff* cited in the Office Action discloses a gateway that receives a fax document and transforms the fax document to a hypertext document. See col. 7, lines 29-30 and 40-49. The documents are stored and identifiers are provided. See col. 7, lines 58-60. However, *Wolff* does not teach or suggest selecting and publishing *a subset* of electronic documents.

Gormish is cited to teach a fax machine that stores a certain number of faxes in order to have archived documents to search. See page 3 of the Office Action. Whether or not this is an accurate characterization of *Gormish*, nothing in *Gormish* appears to teach or suggest selecting and publishing *a subset* of electronic documents.

Epstein is cited to teach content-based filtering. However, *Epstein* is not cited to teach, nor does *Epstein* teach, selecting and publishing *a subset* of electronic documents. Further, as discussed above, *Matsui* is directed to a security strategies for electronic "conversations." Therefore, nothing in the combination of *Wolff*, *Gormish*, *Epstien* and *Matsui* can teach or suggest the invention as claimed in claims 1, 14, 17, 22 and 28. That is, the combination of *Wolff*, *Gormish*, *Epstien* and *Matsui* does not teach or suggest selecting and publishing *a subset* of electronic documents.

Application No. 09/398,229
Amendment dated November 27, 2006
Response to Office Action of August 24, 2006

Atty. Docket No. 74451.P100
Examiner Boutah, Alina A.
TC/A.U. 2143

Claims 4, 29, 30, 37 and 38 depend from claim 1. Claims 31 and 32 depend from claim 14. Claims 33, 34 and 40-42 depend from claim 17. Claims 35, 36 and 43-45 depend from claim 28. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 4 and 29-45 are not rendered obvious by the combination of *Wolff*, *Gormish*, *Epstien* and *Matsui* for at least the reasons set forth above.

Claims 8-13, 15, 16, 18, 23 and 27 were rejected as being unpatentable over *Wolff* in view of *Gormish*, *Epstein* and *Matsui* and further in view of U.S. Patent No. 6,188,673 issued to Bauer, et al. (*Bauer*). *Bauer* is cited to teach the capability to determine and communicate page hits and logging. See Office Action at page 6. However, *Bauer* is not cited to cure, nor does *Bauer* cure, the deficiencies of the combination of *Wolff*, *Gormish*, *Epstein* and *Matsui* set forth above. Therefore, no combination of *Wolff*, *Gormish*, *Epstein*, *Matsui* and *Bauer* can teach or suggest the invention as claimed in claims 8-13, 15, 16, 18, 23 and 27.

In rejecting claim 13, the Office Action takes Official Notice that performing virus removal is "notoriously well known in the art." See Office Action at page 7. However, the Office Action provides no evidence to support the assertion that virus removal was well known in the art *at the time of the filing* of the application. Therefore, in accordance with MPEP §2144.03, Applicant hereby traverses Examiner's Official Notice and respectfully requests that the Examiner either (1) cite a prior art reference that supports such a position pursuant to MPEP § 706.02(a); (2) submit an affidavit pursuant to C.F.R. 1.104(d)(2); or (3) withdraw the obviousness assertion.

Application No. 09/398,229
Amendment dated November 27, 2006
Response to Office Action of August 24, 2006

Atty. Docket No. 74451.P100
Examiner Boutah, Alina A.
TC/A.U. 2143


Claims 5-7, 19-21 and 24-26 were rejected as being unpatentable over *Wolff*, *Gormish*, *Epstein* and *Matsui* and further in view of U.S. Patent No. 6,317,777 issued to Skarbo, et al. (*Skarbo*). *Skarbo* is cited to teach deleting a document or preventing access to the document upon certain conditions. See Office Action at page 9. However, *Skarbo* is not cited to cure, nor does *Skarbo* cure, the deficiencies of the combination of *Wolff*, *Gormish*, *Epstein* and *Matsui* set forth above. Therefore, no combination of *Wolff*, *Gormish*, *Epstein*, *Matsui* and *Skarbo* can teach or suggest the invention as claimed in claims 5-7, 19-21 and 24-26.

Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1 and 3-45 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: Nov 27, 2006


Paul A. Mendonsa
Reg. No. 42,879

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(503) 439-8778